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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|---------------------------|---------------------|------------------|
| 10/810,256 | 03/26/2004 | Olga E. Shmakova-Lindeman | 7780-NES | 8310 |
| 49459 | 7590 | 07/18/2006 | EXAMINER | |
| NALCO COMPANY 1601 W. DIEHL ROAD NAPERVILLE, IL 60563-1198 | | | MOORE, MARGARET G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--|--|
| Office Action Summary | Application No. 10/810,256 | Applicant(s) SHMAKOVA-LINDEMAN, OLGA E. | |
| | Examiner Margaret G. Moore | Art Unit 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 28 is/are pending in the application.
- 4a) Of the above claim(s) 22 to 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election of Group I in the reply filed on 5/10/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Note too that the election of vinyl acetate monomer (c) is maintained from the election noted in the office action of 11/25/05.

2. Claims 1 to 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The basis for the weight percent is unclear. For instance, this could be based on the total weight of the paraffin inhibitor, the total weight of the polymer or the total of (a), (b) and (c) (note for instance that "composed of" allows for the presence of other components). Clarification is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 17 to 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts.

Initially the Examiner refers to MPEP 2111.03 which states the following:

"The transitional phrase "composed of" has been interpreted in the same manner as either "consisting of" or "consisting essentially of," depending on the facts of the particular case."

With this in mind, and noting that the Examiner is supposed to give the claims the broadest reasonable interpretation during examination, the Examiner is giving the phrase "composed of" the breadth of "consisting essentially of". This is consistent with that noted by the previous examiner on page 6 of the action dated 11/25/05. Also found in this section of the MPEP is the following:

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising."

Roberts teaches textile material that contains a terpolymer of an acrylic ester, a vinyl ester and a crosslinking monomer. Particular attention is drawn to Examples IV to VI which show polymers having an acrylate monomer, a methacrylate monomer and vinyl ester, wherein at least one of the acrylate or methacrylate monomers meet the requirement of having a C₁₀ to C₃₀ alkyl group. Since it is not clear that the language "composed of" excludes the addition monomers found in these polymers (glycidyl methacrylate or methylolacrylamide) these monomers are not excluded from the claims.

For claims 17 to 20, see column 3, lines 53 to 56. Note that the upper disclosed value of 7% falls within the range of claim 20. See also the examples which use the polymers in an aqueous emulsion. For claim 21, note that products of identical chemical composition cannot have different properties. As such the composition in Roberts will meet this limitation.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts.

With regard to the molecular weight, Roberts fails to specifically teach this limitation. However, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). In re Aller, 105 USPQ 233. Note too MPEP 2144.05 which specifically mentions molecular weight as it applies to this case law.

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7. Claims 1 to 10, 12 to 15, 17 and 19 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

Miller teaches oil soluble polymers of unsaturated esters having alkyl side chains having from about 18 to 34 carbon atoms. Particular attention is drawn to the bottom of column 4 which shows structural units corresponding to each of (a), (b) and (c) (and an additional "x" unit which is not excluded from the claims). Note that the copolymer can be "mixtures thereof", which indicates a copolymer having each of (a), (b) and (c).

Column 6, lines 61 and on, teach that the amount of "short chain vinyl ester" (which is preferably vinyl acetate) be present in an amount of 10 to about 90 mole percent, the lower limit of which falls within the claimed range of (c). Selecting such an amount of (c) will result in a copolymer having the necessary amount of each claimed monomeric unit such that the teachings in Miller render obvious the claimed polymer

For claim 2, please see column 6, line 60.

For claims 4 to 8 and 12 to 15, please note that adjusting the amount of each monomer unit in an effort to optimize results would have been obvious and within routine experimentation for the skilled artisan.

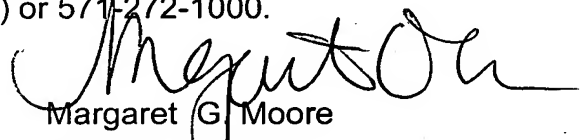
For claim 17 and 19 to 21, see column 7, lines 25 and on.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm

7/12/06